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ATTENTION: Robert K. Nichols II
EXAMINER - ART UNIT 3754

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UNITED STATES DEPARTMENT OF COMMERCE
UNITED STATES PATENT AND TRADEMARK OFFICE

IN ACCORDANCE WITH THE PATENT COOPERATION TREATY

Invention: **IMPROVEMENTS IN TRUNCHEONS
PROTECTIVE BATONS AND CANES**
US National Appln. Serial No.: **10/578,468**
US National Filing Date: **05/05/2006**
International Application No.: **PCT/CA2004/001933**
International Filing Date: **08/11/2004**
Priority Date: **06/11/2003**
Priority Appln. No.: **CANADA 2,453,171**
Applicant: **SITEMAN, WALTER DENIS**
Examiner: **Robert K. Nichols II**
Group Art Unit **3754**
Our File: **SITG008**

Director of the USPTO

January 21, 2009

U.S. Patent and Trademark Office
Mail Stop PCT
Post Office Box 1450
Alexandria, VA, 22313-1450
U. S. A.

Dear Sir:

Applicant is pleased to acknowledge delivery of the Official Report dated December 29, 2008 responsive to Applicant's communication filed on May 5, 2006 and communication later by telephone relating to identification of the group of claims set for examination.

Claims 1-10 are pending in the application. The Examiner holds that those claims are subject to restriction.

A shortened statutory period for reply has been set to expire one(1) month or thirty days, whichever is longer from December 29, 2008, the mailing date.

ELECTION/ RESTRICTION

The Examiner contends that the claims, directed as they are to more than one species of the generic invention, lack unity of invention because they **are not so linked** as to form a single inventive concept under PCT Rule 13.1

PCT Rule 13.1 as in force from January 1, 2009 reads:

“The international application shall relate to one invention only or to **A GROUP OF INVENTIONS so linked as to form a single general inventive concept** (“requirement of unity of invention”)”

PCT Rule 13.2 reads:

Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

“ Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “**special technical features** “ shall mean those technical features **that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.**”

With regard to the characterization by the Examiner that the several species of the application constitute a GROUP of inventions and to his interpretation of PCT Rule 13.2 that such GROUP **fails** to exhibit the “special technical features” that establish a technical relationship among those “inventions of the GROUP,” Applicant contends to the contrary as follows.

Applicant submits with respect that PCT Rule 13.2 interpreted in accord with **Annex B** of

the PCT Rules entitled Unity of Invention, clearly supports Applicant's view that all the claims at issue, correctly construed, exhibit the "**special technical features**" called for in Rule 13.2. which requires that the Examiner hold that "**unity of invention is to be considered fulfilled.**"

Indeed, and in further support of the assertion of **unity of invention** as applying to the claims of record, Applicant cites **PCT Rule 13.4** under which, **permission** is given to Applicant to include in the same international application a reasonable number of **dependent** claims, claiming **specific** forms of the invention claimed in an independent claim, even where the features of any **dependent** claim could be considered as constituting in themselves an invention.

ELECTION

The Examiner has ruled that Applicant is required to elect a "single species" out of several which have been identified by the Examiner as follows:

SPECIES

Species 1: Figures 1-4

Species 2: Figures 5-8

Species 3: Figures 9-11

Applicant **elects Species 2, figures 5-8**, detailing a baton-like structure. Applicant points out however, that Figure 11 discloses a perspective view of a preferred structure of an available commercial spray cannister, depicted in **broken outlines** in the figures of each of the species. See Figure 5 in the elected Species 2. See Figure 1. of Species 1 and Figure 9 of Species 3.

And so Figure 11 should be included **within each of the species**; and from this election be included in Species 2

CLAIMS ENCOMPASSING THE ELECTED SPECIES .

Applicant is also required despite traversing the requirement for restriction, as he does,

to identify those claims reading on the elected species.

Those claims that encompass SPECIES 2 include:

Claims 1, 2, 3, 6, 8 and 10.

ARGUMENT

Claims 1, 2 and 3 appear to be generic, according to the Examiner. Applicant agrees.

Claims 1 and 2 call for a **handle portion** for an **integral shaft portion** in an instrument of **defence**.

Webster's New Dictionary and Thesaurus © Geddes Grossett Ltd., New Lanark, Scotland 1989 defines "**defence**" as – capability or **means of resisting an attack**– amongst other meanings.

Each selected species has a **handle portion integral with a shaft portion**.

Species 1. : shaft 12A; handle 17A.

Species 2. : shaft 12 B; handle 18B

Species 3. : shaft 42C; handle 44C

A truncheon, a baton and a cane are both known and recognized as "**means for resisting an attack**" amongst other utilities.

Each handle portion 17A, 18B and 44C of the several species has a **free end** (unattached) with a **cavity**: 22A, 22B, (the shape of the cavity wall) and 44C, described as the recessed handle respectively; and all with a **mouth** 20A, 20B and as depicted in Figures 8 and 9 wherein the recessed handle 44C is shown respectively about to be and is press fitted with a deterrent/repellant spray unit 48C.

So far each species, within the ambit of claims 1 and 2, is shown to have **more than one** of the same or corresponding **“special technical features”**: namely a handle integral with a shaft wherein the handle has a free end and a cavity with a mouth opening outwardly from the free end.

Then comes the spray dispensing **unit 28A, 28B and 48C** for each embodiment, making up the combination: each **unit** presenting a **spray head** mechanism with a depending **fluid reservoir**, with the **cavity** of the handle **configured** to receive the depending fluid reservoir through the **mouth at the free end** or the depending fluid reservoir **configured** to match the cavity and achieve entry through the **mouth at the free end** and all with an extent and of a **tolerance** that sufficient **gripping engagement against dislodgement** when registered and transported or used in combat is **established**, with the **spray head** sufficiently **exposed** at the **cavity mouth** and at the **ready for actuation**.

Taking the foregoing recited structure of handle with the free end and cavity with mouth opening to the free end and integral with a shaft and adding the detail of the elements and structure of the preceding paragraph, and then considering same **as a whole** to define the inventive concept i.e. patentable invention, **the contribution made over the prior art**, we arrive at the **“special technical features”**, the **link** of PCT Rule 13.2 shown to be embodied in each instrument namely a truncheon, a baton or a cane. All are instruments of defence, the character of each being spelled out in **dependent** claims.

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, **no problem** of lack of unity arises in respect of any such aims that **depend** on the independent claims. PCT Rule 13.1 et sequa. **ANNEX B** Unity of Invention (a) (b) (c) (i).

Further, in the prosecution of the International Application PCT/CA 2004/001933 under the then applicable PCT Rules and upon which this US national application is based, the issue of unity of invention raised by the Examiner did **not** arise in relation to the claims of record, which supports

the contention that the terms of the controlling Unity of Invention PCT Rules have been satisfied, and which Applicant asserts is confirmed by the foregoing analysis.


Finally where as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C.121 is never proper. MPEP S806.05

TRAVERSE

Accordingly Applicant formally **traverses** the requirement that this application should be made subject to ELECTION/RESTRICTION under the applicable protocol in the United States Patent and Trademark office.

The agent for the Applicant brings forward the following: His e-mail address has changed . It now reads; wfgreenpat@bellnet.ca Will the Examiner kindly amend that entry in this file.

All of which is respectfully submitted,


Weldon F. Green
Agent for the Applicant

wfg/gs

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